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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,016	09/20/2001	Alain Gantier	P21432	3081

7055 7590 07/22/2003

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RESTON, VA 20191

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

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DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,016

Applicant(s)

GANTIER, ALAIN

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22 and 25-48 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. It is noted that the term “snowboard boot” in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.
3. Claims 14-18 and 20-22, 25-26, 28-30, 35-42 and 44-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellis (3,206,874). Ellis `874 discloses an assembly comprising: a shoe and a device (foot protector 34 with guard flap 36) for flexural stiffening and/or protection of the shoe; said shoe having a flexion fold zone (the location of the flexion fold zone is dependent on the type and size of the shoe and will vary from one type of a shoe to another), an upper front surface, a front end zone, said device including a cover covering said upper front surface of said shoe and extending from said flexion fold zone of said shoe to said front end zone of said shoe.

With respect to claims 16, 17, 20-22, 37, 38, 46 and 47, note the journal connection/insert (hinge 40 and plate 38) in Figures 1 and 2 embodiments.

With regard to claims 25 and 45 and the material of the cover, see column 3, lines 2-6.

With regard to claim 26 and the immobilizing means, note the rivet (45) in Figures 1 and 2 embodiments.

4. Claims 14-18 and 20-22, 25-26, 28-30, 35-42 and 44-47 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Donnell 93,068,593. O'Donnell '593 discloses an assembly comprising: a shoe and a device (foot protector flap 32) for flexural stiffening and/or protection of the shoe; said shoe having a flexion fold zone (the location of the flexion fold zone is dependent on the type and size of the shoe and will vary from one type of a shoe to another), an upper front surface, a front end zone, said device including a cover covering said upper front surface of said shoe and extending from said flexion fold zone of said shoe to said front end zone of said shoe.

With respect to claims 16, 17, 20-22, 37, 38, 46 and 47, note the journal connection/insert (furrules 31 and studs 36) in Figures 1-4 embodiments.

With regard to claims 25 and 45 and the material of the cover, see column 2, lines 27-29.

With regard to claim 26 and the immobilizing means, note the screw (41) in Figures 1-4 embodiments.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 27, 43 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis `874. Ellis `874 discloses that the cover can be made of different materials which inherently will have different rigidity. (see column 3, lines 2-6). Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of covers made from different materials having varying rigidities, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

7. Claims 19 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis `874 in view of ETABLISSEMENTS JACQUES LANDRY (FR 2 361 837). Ellis `874 as described above discloses all the limitations of the claims except for the device including tightening straps and the specifics of the size of the device. LANDRY discloses an assembly comprising: a shoe and a device (2) for flexural stiffening and/or protection of the shoe; said device comprising tightening straps for better securing the device to the shoe. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide tightening straps to the device of Ellis `874 as taught by LANDRY to better secure the device to the shoe.

With respect to claims 19 and 31, it would have been an obvious matter of design choice to modify the shape and size of the device since such a modification would have involved a mere change in the size and shape of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

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8. Claims 19 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell `593 in view of ETABLISSEMENTS JACQUES LANDRY (FR 2 361 837). Ellis `874 as described above discloses all the limitations of the claims except for the device including tightening straps and the specifics of the size of the device.

LANDRY discloses an assembly comprising: a shoe and a device (2) for flexural stiffening and/or protection of the shoe; said device comprising tightening straps for better securing the device to the shoe. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide tightening straps to the device of O'Donnell `593 as taught by LANDRY to better secure the device to the shoe.

With respect to claims 19 and 31, it would have been an obvious matter of design choice to modify the shape and size of the device since such a modification would have involved a mere change in the size and shape of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Allowable Subject Matter

9. Claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed May 07, 2003 have been fully considered but they are not persuasive. Contrary to applicant's argument the device of Ellis `874 and

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O'Donnell' 593 do indeed cove the flexion fold zone of their shoe. The location of the flexion fold zone is dependent on the type and size of the shoe and will vary from one type of a shoe to another.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech

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Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner Mohandesi of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

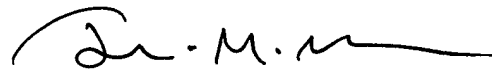
Inquiries only concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

Check out our web-site at "www.uspto.gov" for fees and other useful information.

J. MOHANDESI
PATENT EXAMINER



Jila M Mohandesi
Examiner
Art Unit 3728

JMM
July 21, 2003